REMARKS

Claim 47, which was an inadvertent duplicate of claim 31, has been canceled. Claim 49, which was inadvertently canceled instead of claim 47 in the Reply of May 30, 2001 has been added back as new claim 50.

The allegation that Stockemann *et al.*, DE 4344463 ('463) anticipates the instant claims is in error. Although '463 may disclose a range of ovulation-inhibiting doses of a progesterone antagonist, it does not describe an ovulation inhibiting dose of a progesterone antagonist in the context of a multiphase preparation comprising a first phase comprising a progesterone antagonist and a second phase comprising a gestagen. In fact, '463 is drawn to methods and compositions using a progesterone antagonist in a non-ovulation inhibitory dose, rather than an ovulation-inhibitory dose. In order for a reference to be anticipatory, it must disclose every element of a claim. That is clearly not the case here.

Furthermore, Stockemann does not render the instant claims obvious. Nothing in the prior art of record would motivate a worker to select an ovulation inhibiting dose for the antiprogestin and use that dose in the "combination" disclosed by the prior art. See column 2, line 45 - column 3, line 1. Absent such motivation, with the requisite expectation of success, the cited reference does not render the claimed invention obvious.

The rejections under 35 USC 102(a) and 103 (a) should thus be withdrawn.

The rejection under 35 USC 112, first paragraph is traversed. Contrary to the allegation of the Examiner, there is no confusion as to whether the dosages of antiprogesterone (RU 486 or other progesterone antagonists) disclosed in the cited reference, USP 6,225,297 (" '297") (which

is the English language equivalent of '463) and the instant specification are ovulation-inhibitory or non-ovulation-inhibitory.

By way of clarification, it is noted that the instant application and the '297 patent are directed toward very different properties (*e.g.*, mechanisms of action) of antiprogesterones. Further, the amounts (dosages) of the antiprogesterones used are those which are required to achieve these different properties.

The instant application specification and claims are directed toward, *i.a.*, ovulation-inhibiting dosages of a competitive progesterone antagonist. The specification clearly teaches that one can determine what dosages of a competitive antiprogesterone are ovulation inhibiting, *e.g.*, by testing for serum progesterone levels in female cynomolgus monkeys (specification, p. 9, lines 14-19) or in women (lines 25-27). These amounts, of course, will vary with the activity level of the particular compound involved, the patient's condition etc. However, in all cases, as the instant claims specify, the amount used will be ovulation inhibiting. Hence, applicants' specification provides sufficient guidance to objectively enable one of ordinary skill in the art to make and use the invention, for example, to determine ovulation inhibiting amounts of competitive antiprogesterone using no more than routine experimentation.

By contrast, the '297 patent is directed toward, *i.a.*, amounts of competitive progesterone antagonists which are non-ovulation-inhibiting. See again column 2, line 65 - column 3, line 1. That specification teaches how to determine what dosages of a competitive antiprogesterone are non-ovulation-inhibiting, and the claims specify that the amount used will be non-ovulation inhibiting.

The instant specification and the cited reference discuss both RU486 and other

progesterones. For purposes of clarity, these two groups are considered separately below.

With regard to dosages of the competitive antiprogesterone, RU 486: The '297 patent discloses at, *e.g.*, col. 5, lines 18-21, that a dosage of RU 486 of 0.1-5 mg is non-ovulation inhibiting, and at col. 2, lines 61-64, that a dosage of RU 486 of 2-5 mg is ovulation inhibiting. Still, the '297 specification makes it clear to a skilled worker to select within the range of 0.1-5 mg only those amounts which do not inhibit ovulation. The instant specification teaches at page 9, lines 22-24 that a typical ovulation inhibiting dosage of RU 486 is 2 mg. This is perfectly consistent with the disclosure in '297 that a dosage of 2-5 mg is ovulation inhibiting. One of skill in the art can readily select which dosages disclosed in either the present specification or the prior art reference are ovulation inhibitory, and which are non-ovulation inhibitory. There is no contradiction between the two disclosures.

As for ovulation-inhibitory dosages of progesterone antagonists other than RU 486: Typical ovulation-inhibitory amounts for "other competitive progesterone antagonists" disclosed in the instant specification are in the range of 0.01-30 mg (page 9, lines 22-24); and a typical amount for one such agent, (Z)-11ß-[(4-dimethylamino) phenyl] -17ß-hydroxy-17 α- (3-hydroxy-1-propenyl)estra-4-en-3-one, lies within this range, at 0.01 to 5 mg. (see, *e.g.*, claim 14). The '297 patent discloses a non-ovulation-inhibitory dosage range of 0.1 to 50 mg for yet another antiprogestin, onapristone (11ß-[(4-dimethylamino) phenyl] -17α-hydroxy-17ß- (3-hydroxypropyl) -13α-methyl-4, 9 (10) -gonadien-3-one).

The fact that some of the values in the instantly disclosed range of ovulation-inhibitory dosages, 0.01 to 30 mg, overlap with the amounts (0.1 to 50 mg) disclosed in the prior art as being non-ovulation inhibitory for a different antiprogestin, onapristone, is not contradictory.

For one thing, onapristone is only one species of the genus of competitive antiprogesterones. As noted above, the specific dosages of each agent will vary. In any case, as discussed above, one of skill in the art can readily determine which dosages are ovulation inhibitory, and which are non-ovulation inhibitory. The amount employed for each agent in the present invention must be ovulation-inhibiting within the general range. There is no contradiction between the two disclosures.

Therefore, the rejection under 35 U.S.C. §112, first paragraph, should be withdrawn.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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